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I. INTRODUCTION

Defendant Swift-Eckrich, Inc. d/b/a ConAgra Refrigerated Foods (“Swift-Eckrich”) is the owner by assignment of U.S. Patent No. 5,952,027 (the “‘027 Patent”), directed to an innovative method of browning precooked whole muscle meats. The ‘027 Patent was issued on September 14, 1999, based on an application filed on May 11, 1998, and is presumed valid. 35 U.S.C. § 282.

Despite this presumption, plaintiffs Unitherm Food Systems, Inc. (“Unitherm”) and Jennie-O Foods, Inc. (“Jennie-O) ask this court to find, without a trial, that the ‘027 Patent is invalid under 35 U.S.C. §§ 102(b) and 103 because Unitherm allegedly demonstrated, offered for sale and sold the “Unitherm process” before May 11, 1997. Plaintiffs also claim that the ‘027 Patent is unenforceable because Swift-Eckrich allegedly concealed material prior art from the Patent and Trademark Office (the “PTO”). Since Plaintiffs have not proved by clear and convincing evidence that the ‘027 Patent is invalid or unenforceable, Plaintiffs’ motion should fail for the following reasons:

1. Plaintiffs admit that all of the alleged demonstrations of the “Unitherm system” were performed pursuant to agreements of confidentiality and secrecy. The existence of such confidentiality agreements are strong evidence against a finding of public use under § 102(b).
2. Plaintiffs do not establish, by clear and convincing evidence, that the “Unitherm process” meets each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. In addition, Plaintiffs’ motion should be denied because of Plaintiffs’ improper construction of the terms “browning liquid pyrolysis product” and “golden brown.”
3. Plaintiffs’ motion is supported by exhibits attached to the affidavit of David Howard. However, these exhibits are inadmissible and should be stricken because they are not properly authenticated and/or are hearsay. Plaintiffs’ motion should thus be denied for lack of proof.

4. Plaintiffs' claim that Swift-Eckrich commercialized its patent also fails because there is no evidence, much less clear and convincing evidence, that Swift-Eckrich ever sold product produced by its experiments.

5. Finally, inequitable conduct is a question of fact which is not conducive to resolution on summary judgment. There is no clear and convincing evidence that Swift-Eckrich intentionally withheld any material information from the PTO. In fact, the Description of Related Art in the '027 Patent - which appears to encompass the "Unitherm process" - describes the prior conventional approaches used in attempting to brown pre-cooked whole muscle meats and thus precludes Plaintiffs' argument.

II. STATEMENT OF MATERIAL FACTS TO WHICH SWIFT-ECKRICH ASSERTS GENUINE ISSUES OF FACT EXISTS.

Pursuant to LCvR 56.1(c), Swift-Eckrich hereby lists those material facts to which it asserts a genuine issue exists. The numbers of Swift-Eckrich's statements correspond with the numbers of Plaintiffs' statements of material facts:

1. Swift-Eckrich agrees that May 11, 1997 is the date one year prior to the filing of the '027 Patent application.

2. The claims of the '027 Patent are to be construed in view of the specification and the prosecution file history of the patent. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed Cir. 1996). Plaintiffs' attempt to construe claims of the '027 Patent by using fragmentary quotations and excerpts is inadequate and misleading. For example, Plaintiffs assert that a liquid smoke product is a "browning liquid pyrolysis product." (Plaintiffs' Motion, p. 3 fn. 2). In truth, there are a number of liquid smoke products which **do not** even promote the browning of meats.

Liquid smoke products, therefore, are not necessarily “browning liquid pyrolysis products” as that term is defined in the ‘027 Patent. (Salm Decl., ¶¶ 3, 4, attached hereto as Exhibit A.)

3. Plaintiffs’ attempt to construe the term “golden brown” in the ‘027 Patent claims is inadequate and misleading.¹ (See Civille Decl., ¶¶ 3, 4, attached hereto as Exhibit B.) For example, Plaintiffs have not provided L, A and B values, or any other objective color measurement or definition, for any product which they claim to be “golden brown.” (Civille Decl., ¶ 3.) See Response To Statement No. 2.

4. Swift-Eckrich incorporates by reference Response To Statement Nos. 2 and 3.

5. Swift-Eckrich incorporates by reference Response To Statement Nos. 2 and 3.

6. Swift-Eckrich incorporates by reference Response To Statement Nos. 2 and 3.

7. Paul Corrigan of Corrigan Brother’s Butchers Ltd. in the United Kingdom had a confidentiality agreement with Unitherm. (Unitherm’s Response to Interrogatory No. 4, attached hereto as Exhibit C.) The “process” allegedly performed by Unitherm occurred in the United Kingdom (Corrigan Depo., 10:7-9, attached hereto as Exhibit D.) There is no evidence that the “process” met each of the limitations of the claims of the ‘027 Patent and thus was an embodiment of the claimed invention. In addition, Mr. Corrigan’s testimony is not credible.²

¹ It should be noted that Swift-Eckrich did not stipulate that “golden brown” included a “smoked color.” (Plaintiffs’ Motion, p. 3.) Rather, Swift-Eckrich stated that its first reduction to practice in 1988 or 1989 of the patented process resulted in a “smoked color.” (Swift-Eckrich’s Response to Interrogatory No. 3, attached hereto as Exhibit B.)

² David Howard paid for Mr. Corrigan to come to the United States to testify (Corrigan Depo., 29:6-10, Exhibit D.) David Howard refreshed Mr. Corrigan’s recollection as to events which occurred 12 years before (Corrigan Depo., 30:18-21.) There are no documents or agreements which support his testimony (Corrigan Depo., 31:15-22.) Mr. Corrigan did not know what a liquid pyrolysis product was or whether Mr. Howard used a liquid pyrolysis product (Corrigan Depo., 32:20, 33:3-6.)

8. The undated video (Exhibit 80 to Howard Affidavit) is inadmissible because it has not been properly authenticated.³ There is no evidence that the “process” being videotaped (as well as any demonstration of the alleged “Unitherm process”) met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention.⁴ This demonstration was performed pursuant to a confidentiality agreement - - as were all other demonstrations by Unitherm to any potential customer. (Unitherm’s Response to Interrogatory No. 4, Exhibit C; Plaintiffs’ Response to Request For Admission No. 13, attached hereto as Exhibit E; Howard Depo., 66:23-67:2; 68:16-69:14; 70:20-71:1; and 110:12-15, attached hereto as Exhibit F.)

³ Mr. Howard does not state in his affidavit who took the video or whether the video is an accurate representation of the alleged tests performed. (Howard Affidavit, ¶ 2.) In addition, as described more fully in footnote 124, infra, and the Civille Declaration, attached hereto as Exhibit B, Plaintiffs cannot rely on video pictures, photographs, computer printouts or visual observation (without measurements) to accurately reflect a “golden brown” color of the product being taken. Thus, Swift-Eckrich moves to strike this evidence.

⁴ For example, there is no evidence (a) that the product produced was “golden brown” as that term is defined in the ‘027 Patent; (b) that the liquid smoke allegedly used was a “browning liquid pyrolysis product” as that term is defined in the ‘027 Patent; (c) of the percentage pickup of the “browning liquid pyrolysis product” as claimed in the ‘027 Patent; (d) whether the “browning liquid pyrolysis product” contained a masking agent or flavoring enhancing composition as claimed in the ‘027 Patent; (e) whether the “browning liquid pyrolysis product” contained turkey flavor, turkey broth or a mixture of the two as claimed in the ‘027 Patent; (f) of the temperature of the core of the product both before and after browning as claimed in the ‘027 Patent; (g) that the pre-cooked whole muscle meat was predried prior to coating with a “browning liquid pyrolysis product” as claimed in the ‘027 Patent; and (h) whether the shrinkage of the product comports with the claims in the ‘027 Patent.

9. The September 1 and 15, 1993 data sheets for an alleged Rocco test (Exhibit 2 to Howard Affidavit) have not been properly authenticated⁵ and are inadmissible hearsay.⁶ There is no evidence that the "process" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention.⁷ This demonstration was performed pursuant to a confidentiality agreement. (See Swift-Eckrich's Response To Statement No. 8, supra.)

10. The sales proposal to Rocco on September 23, 1993 (Exhibit 3 to Howard Affidavit)⁸ is for the sale of equipment,⁹ not a process. The system capacities (which means the number of turkey breasts which could run through the oven each hour) were apparently based on the test parameters established on September 15, 1993. There is no evidence that the September 15, 1993 tests met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement Nos. 8 and 9, supra.)

⁵ Mr. Howard does not state who recorded the data for these tests, that he was present for the tests or that the data sheets accurately reflect the test results. (Howard Affidavit, ¶ 3.) Thus, Swift-Eckrich moves to strike these exhibits. See Countryside Oil Co., Inc. v. Travelers Ins. Co., 928 F. Supp. 474, 482 (D.N.J. 1995) (unauthenticated document may not be relied upon in summary judgment brief); Burnett v. Stagner Hotel Courts, Inc., 821 F. Supp. 678, 683 (N.D. Ga. 1993).

⁶ The information in these data sheets are inadmissible hearsay since Plaintiffs are using these document to show the truth of the recorded data. For that reason, Swift-Eckrich moves again to strike these exhibits. See Dotson v. Electro-Wire Prods., Inc., 890 F. Supp. 982, 992 (D. Kan. 1995); Countryside Oil Co., Inc. v. Travelers Ins. Co., 928 F. Supp. 474, 482 (D.N.J. 1995).

⁷ For example, the only mention of a golden brown color in these data sheets relates to the result of **undipped** product (i.e., product in which no browning liquid was applied) on September 15, 1993.

⁸ Swift-Eckrich moves to strike this exhibit as inadmissible hearsay since the foundational requirements for the business record exception have not been met. See Dotson v. Electro-Wire Prods., Inc., 890 F. Supp. 982, 992 (D. Kan. 1995); Countryside Oil Co., Inc. v. Travelers Ins. Co., 928 F. Supp. 474, 482 (D.N.J. 1995).

⁹ Specifically, the proposal is to sell a RapidFlow II oven (U-06081-02).

11. The October 14, 1993 test data sheets for an alleged Rocco test (Exhibits 4A and 4B to Howard Affidavit) have not been properly authenticated and are inadmissible hearsay.¹⁰ Not only was the October 14, 1993 demonstration performed pursuant to a confidentiality agreement, there is no evidence that this test, like the September 1 and 15, 1993 tests described above, met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹¹

12. The fax from Rocco to Unitherm dated November 9, 1993 (Exhibit 5 to Howard Affidavit)¹² describes "browning tests" to be performed. It does not identify any of the parameters of the test. There is no evidence that any such confidential tests (if they were ever conducted) met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

13. Although Plaintiffs claim that Red Arrow "participated in numerous sales presentations and live demonstrations of the Unitherm process," Plaintiffs fail to prove any of the

¹⁰ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these exhibits. Furthermore, there is a discrepancy in these data sheets. Document U-05941 (in Exhibit 4A), which is a typed version of the handwritten test data sheet in Document U-05948 (in Exhibit 4B), does not indicate that a combination of Maillose and smoke were applied to the product. Swift-Eckrich also moves to strike the fax from Jim Hutchinson to Daniel Benson of Rocco Document dated October 14, 1993 (Exhibit 4A to Howard Affidavit (Document U-05939)). Mr. Howard does not authenticate this fax. In addition, this exhibit constitutes inadmissible hearsay since the foundational requirements for the business record exception have not been met.

¹¹ For example, even assuming that Maillose was applied, there is no indication that the resulting product was "golden brown." The only reference to color is that "the color is good." (U-05939.) In addition, there is no evidence that pre-cooked whole muscle meats were used in these tests. Rather, the data sheet reflects only that "turkey breasts" were used.

¹² For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

elements of the “Unitherm process” or that the “Unitherm process” met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.) Contrary to paragraph 12 of Mr. Howard’s affidavit, Unitherm has admitted that Red Arrow had an agreement with Unitherm to maintain the secrets of Unitherm. (Unitherm’s Response to Interrogatory No. 4, attached hereto as Exhibit C; Plaintiffs’ Response to Request For Admission Nos. 12 and 13, attached hereto as Exhibit E; Howard Depo., 110:12-112:5, attached hereto as Exhibit F.)

14. Exhibit 66 to the Howard Affidavit does not support Plaintiffs’ claim that “Unitherm and Red Arrow were ‘not working exclusively with each other.’” The letter from Ron Ratz of Red Arrow to David Howard, dated December 29, 1996 (Exhibit 9 to Howard Affidavit) is inadmissible hearsay.¹³ There is no evidence that the “unique Red Arrow/Rapid Flow process” (which is never described) met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.) Unitherm does confirm, however, that its joint effort with Red Arrow “is based on the assumption that we have a **unique oven** where uniform, consistent high heat is particularly effective with your products.” (Exhibit 8 to Howard Affidavit) (emphasis added).)

15. Any demonstration conducted by Unitherm for Rocco and others in 1993 were performed pursuant to a confidentiality agreement. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.) The only exhibit offered to support the facts alleged in Statement of Material Facts No. 15 relating to these **1993** demonstrations is a cooking trial data sheet dated **February 3, 1994** for

¹³ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit.

Rocco. (Exhibit 11 to Howard Affidavit.)¹⁴ There is no evidence that Unitherm conducted any demonstration of a process in 1993 (or any other date) which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹⁵ In fact, the data sheets for these 1993 demonstrations (attached as Exhibits to the Howard Affidavit), do not support Plaintiffs' recitation of what these demonstrations included.¹⁶ (See Swift-Eckrich's Response To Statement Nos. 9 and 11, *supra*.)

16. The video allegedly filmed on September 14, 1993 (Exhibit 81 to the Howard Affidavit) is inadmissible because it has not been properly authenticated.¹⁷ The video merely promotes the RapidFlow oven, not "the Unitherm in-line browning/smoking process" as Mr. Howard states. (Howard Affidavit, ¶ 14.) No "process" shown on this video meets each of the limitations of

¹⁴ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike this exhibit.

¹⁵ It should be noted that Plaintiffs' Statement No. 15 **does not** state that any of these demonstrations resulted in a "golden brown" color as that term is defined in the '027 Patent.

¹⁶ Plaintiffs also rely on Unitherm's Responses to Interrogatory Nos. 1 and 8. However these responses are neither credible or reliable because Unitherm purportedly describes specifics of tests conducted eight years earlier that were never recorded in data sheets or in any other document. For example, Unitherm claims (without any documentary support) that there was "liquid pickup amounts ranging from less than 0.1% by weight to about 1.5% by weight." Furthermore, these Interrogatory responses do not claim that the finished product's L, A, and B values were measured; therefore, there is no way to verify that Unitherm's description of "golden brown" comports with the "golden brown" color claimed in the '027 Patent. (Civille Declaration, ¶ 3, Exhibit B.) Finally, Plaintiffs rely on the Affidavit of Amanda Howard, the wife of David Howard. (Howard Depo., 366:3, attached hereto as Exhibit F.) Mrs. Howard also testifies about specific parameters of tests that were purportedly performed nine years earlier without any documentary support; therefore, her affidavit is neither credible nor reliable.

¹⁷ For the reasons described more fully in footnote 3, *supra*, Swift-Eckrich moves to strike this exhibit.

the claims of the '027 Patent so as to embody the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹⁸

17. The transmittal letters¹⁹ confirm that the video was sent to sell an oven,²⁰ not a process. As discussed in Swift-Eckrich's Response To Statement No. 16, *supra*, the video does not show a process which meets each of the limitations of the claims of the '027 Patent.²¹ Finally, Unitherm has admitted that the "sales materials, proposals and correspondence" which it sent to potential customers were marked confidential or secret. (Plaintiffs' Response to Request For Admission No. 18.)²²

18. The video allegedly filmed on September 14, 1993 (Exhibit 82 to the Howard Affidavit) is inadmissible because it has not been properly authenticated.²³ Swift-Eckrich incorporates by reference its Response To Statement No. 16, *supra*.²⁴

¹⁸ Dave Howard states in his affidavit that these products have "golden brown colors of various shades." Howard Affidavit, ¶ 18. There is no attempt, however, to match these colors with L, A and B values, or to otherwise define or measure the color.

¹⁹ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 15-20 to Howard Affidavit as inadmissible hearsay.

²⁰ See Exhibit 15 to Howard Affidavit ("this oven really does a job with very high yields"); Exhibit 16 ("[i]t's a unique convection oven"); Exhibit 17 ("the oven is well balanced with a very gentle air movement"); Exhibit 18 ("[i]n addition to the oven, you must meet the people of Unitherm"); Exhibit 19 ("[t]he literature is on our RapidFlow II Oven"); Exhibit 20 ("[t]he uniform air handling characteristics of our oven did the rest").

²¹ Mr. Howard testified that he could not remember any publication, including videos, before May 1997, that actually explained the process so that someone would be able to use it. (Howard Depo., 318:1-22, Exhibit F.)

²² Mr. Howard also testified that he was not aware of any individual, who was not under an obligation of secrecy to Unitherm, which knew how to carry out his "process" before May 1997. (Howard Depo., 317:1-23; 314:10-315:14, attached hereto as Exhibit F.)

²³ For the reasons described more fully in footnote 3, *supra*, Swift-Eckrich moves to strike this exhibit.

²⁴ Mr. Howard states in his affidavit that these products have "a dark golden brown color." Howard Affidavit, ¶ 20. There is no attempt, however, to match this color with L, A and B values or to measure the color in any other way.

19. The videos attached as Exhibit 82 to the Howard Affidavit and as Appendix V are inadmissible because they have not been properly authenticated.²⁵ Swift-Eckrich incorporates by reference its Response To Statement No. 16, *supra*.

20. The purported transmittal letters²⁶ confirm that the video was sent to sell an oven,²⁷ not a process. Plaintiffs fail to describe any of the elements of the “the in-line smoke process” and whether that “process” met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.)²⁸ Finally, these videos were marked confidential. (See Swift-Eckrich’s Response To Statement No. 17, *supra*.)

21. Swift-Eckrich incorporates by reference its Response To Statement No. 20.

22. Syed Hussain conducted an experiment at Unitherm’s facility in Elk Grove in which Maillose was applied to the surface of a fully cooked turkey breast.

23. The September 30, 1993 data sheet for an alleged Swift-Eckrich experiment (Exhibit 22 to Howard Affidavit) has not been properly authenticated and is inadmissible hearsay.²⁹

²⁵ For the reasons described more fully in footnote 3, *supra*, Swift-Eckrich moves to strike Exhibit 82 and Appendix V.

²⁶ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibit 21 to Howard Affidavit as inadmissible hearsay.

²⁷ See Exhibit 21 to Howard Affidavit (“Unitherm Food Systems, Inc. is not in the mainstream of equipment suppliers, so this equipment will be new news” [U-01046]; “Enclosed is our full product catalog as well as our newest video tape showing a selection of our product line in operation” [U-01176]; “I think you will be particularly interested in our RapidFlow Oven, which provides uniform results when used to apply liquid smoke to poultry products” [U-06229]; and “Enclosed is a catalog of our equipment and our latest video for your use” [U-00383]).

²⁸ It should be noted that the '027 Patent refers to a browning process, not a smoking process.

²⁹ Dr. Hussain testified that the data sheet was not generated in his presence, not addressed to him and, therefore, he could not verify that the information contained in the data sheet was accurate. (Hussain Depo., 112:4-6; 113:21-114:3, attached hereto as Exhibit G.) For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike this exhibit.

There is no evidence that this experiment³⁰ met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)³¹ Unitherm admits that there was an agreement with Swift-Eckrich imposing obligations of confidentiality with respect to this demonstration. (Plaintiffs' Response to Request For Admission No. 10, attached hereto as Exhibit E; Howard Depo., 75:15-76:1, attached hereto as Exhibit F; Swift-Eckrich's Response To Statement No. 8, *supra*.)

24. The sales proposal to Swift-Eckrich on October 6, 1993 (Exhibit 24 to Howard Affidavit)³² is for equipment, not a process.³³ There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).³⁴

25. Plaintiffs deny that Swift-Eckrich disclosed the process to Unitherm. Rather, Plaintiffs contend that Unitherm disclosed the process at issue to Swift-Eckrich (which Swift-Eckrich denies). (See First Amended Complaint, attached hereto as Exhibit H; Plaintiffs' Statement Of Material Facts, No. 76.)

³⁰ The only experiment which involved pre-cooked whole muscle meats was Test No. 3.

³¹ For example, Dr. Hussain testified that the color was "brown" not "golden brown." (Hussain Depo., 161:8-16, attached hereto as Exhibit G.) Also, Dr. Hussain testified that he did not know whether he ever achieved a "golden brown" color as that term is defined in the '027 Patent. (Hussain Depo., 173:12-24.) The only reference to a color in the data sheet is that the color was "excellent."

³² For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

³³ Dr. Hussain testified that this was a proposal to sell equipment, not a process. (Hussain Depo., 122:4-23, attached hereto as Exhibit G.)

³⁴ For example, Dr. Hussain did not agree that this proposal involved a process using Maillose. (See Hussain Depo., 122:16-23, attached hereto as Exhibit G.) In addition, the sales proposal's reference to capacities relates solely to the numbers of turkey breasts which could run through the oven each hour, and not to any "process."

26. The October 14, 1993 data sheet for an alleged Swift-Eckrich experiment, and the transmittal letter (Exhibit 25 to Howard Affidavit), have not been properly authenticated and are inadmissible hearsay.³⁵ There is no evidence that this experiment met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)³⁶ This demonstration was performed pursuant to a confidentiality agreement. (See Swift-Eckrich's Response To Statement No. 23, *supra*.)

27. Swift-Eckrich does not dispute this statement.

28. Unitherm admits that it never disclosed the "process" to Thorn Apple Valley or told Thorn Apple Valley how the "process" worked. (Howard Depo., 87:15-21, attached hereto as Exhibit F.) Arnold Mikelberg did not know what the "process" was.³⁷ Contrary to Plaintiffs' assertions, Mr. Mikelberg did not testify that Unitherm was selling (or sold) a "process" to Thorn Apple Valley.³⁸ There is no evidence that any demonstration to Thorn Apple Valley met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.) Unitherm performed its demonstrations for

³⁵ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these exhibits.

³⁶ For example, there is no evidence that a "browning liquid pyrolysis product" was used during this experiment. See Hussain Depo., 173:12-24, attached hereto as Exhibit G (never achieved a "golden brown" color).

³⁷ Mr. Mikelberg testified that (a) "I don't know exactly what that process was" (Mikelberg Depo., 60:5-6, attached hereto as Exhibit I); (b) he did not know whether Maillose was used in the "process" (*Id.*, 28:23-29:3); (c) he was not able to technically read the '027 Patent (*Id.*, 48:20-22; 49:17-20) or to determine what invention is claimed in a patent (*Id.*, 71:6-11); (d) he did not know what a liquid pyrolysis product was (*Id.*, 49:22-24; 60:25-61:2) or whether a pyrolysis product was used (*Id.*, 61:3-5); and (e) only the "principle" described in the '027 Patent is similar to what Mr. Howard presented (*Id.*, 48:22-24.)

³⁸ Rather, Mr. Mikelberg testified that it was his understanding that Unitherm was selling a process, not just an oven, to Swift-Eckrich. (Mikelberg Depo., 55:19-56:1, attached hereto as Exhibit I.)

Thorn Apple Valley pursuant to a confidentiality agreement. (See Plaintiffs' Response to Request For Admission No. 17, attached hereto as Exhibit E; Howard Depo., 91:2-13 and 93:5-94:9, attached hereto as Exhibit F; and Swift-Eckrich's Response To Statement No. 8, *supra*.)

29. The sales proposal to Thorn Apple Valley on July 24, 1995 (Exhibit 26 to Howard Affidavit) and the related sales order, order confirmation and invoice (Exhibits 27-29 to Howard Affidavit)³⁹ are for the sale of equipment, not a process. Contrary to Plaintiffs' assertions, Mr. Mikelberg did not write (or testify) that Thorn Apple Valley "purchased the Unitherm process." Rather, Mr. Mikelberg wrote that "Thorn Apple Valley at a later date purchased **this equipment** from Unitherm to smoke ham product for Boston Markets." (Exhibit 2 to Mikelberg Depo., attached hereto as Exhibit J) (emphasis added.)⁴⁰ There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).⁴¹

30. There is no evidence which describes the "Unitherm process" or that it met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.) In addition, there is no evidence that the Unitherm "process," as opposed to equipment, was sold. Thus, there is no evidence to support what

³⁹ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 26-29, inclusive, as inadmissible hearsay.

⁴⁰ Plaintiffs are also mistaken in claiming that the letter dated July 17, 1996 from Mr. Gaydusek (Exhibit 31 to Howard Affidavit) states that the "Unitherm process was already operating at Thorn Apple." Rather, this letter merely confirms that Unitherm has "successfully implemented a casing removal and rinse station at Thorn Apple Valley's new facility in Ponca City, Oklahoma." (U-02276.) In addition, a letter from Mr. Howard dated January 15, 1996 (Exhibit 30 to Howard Affidavit) refers only to a "Smoked Meats line." Furthermore, for the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 30 and 31 because they are inadmissible hearsay.

⁴¹ It should be noted that Thorn Apple was using the equipment to "smoke hams." Therefore, there is no evidence that a "browning liquid pyrolysis product" was used.

Thorn Apple, Hudson Foods and Jennie-O were doing "prior to the Unitherm process" - let alone any explanation what that phrase means.

31. There is no evidence to support what the "typical" beginning core temperature of "the product" (which is undefined) was in a conventional batch process. Exhibit 31 to the Howard Affidavit refers only to a packaging temperature of 45° F. (U-02277.) To the extent it is considered, Appendix M appears to state that the beginning internal temperature is 165 degrees (FF-00344).⁴²

32. The alleged "seminar" conducted in January 1994 was confidential. (First Amended Complaint, ¶ 20, attached hereto as Exhibit H; Plaintiffs' Response to Request For Admission Nos. 11 and 12, attached hereto as Exhibit E; Swift-Eckrich's Response To Statement No. 23, *supra*.) There is no evidence that the demonstration to Swift-Eckrich met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).⁴³

33. The January 13, 1994 data sheet for an alleged Carolina Turkey test (Exhibit 34 to Howard Affidavit) has not been properly authenticated and is inadmissible hearsay.⁴⁴ Not only was this demonstration performed pursuant to a confidentiality agreement (see Swift-Eckrich's Response To Statement No. 8, *supra*), there is no evidence that it met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See

⁴² For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike the documents in Appendix M and Exhibit 31 as inadmissible hearsay. In addition, the document in Appendix M has not been authenticated.

⁴³ For example, there is no evidence that a "golden brown" color was achieved.

⁴⁴ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these exhibits.

Swift-Eckrich's Response To Statement No. 8, *supra*.)⁴⁵ In addition, the sales proposal to Carolina Turkey on January 27, 1994 (Exhibit 35 to Howard Affidavit) and to Corfu Tasty Gyros on February 18, 1994 (Exhibit 36 to Howard Affidavit)⁴⁶ are for the sale of equipment, not a process. There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁴⁷

34. Unitherm's letter to House of Raeford dated August 18, 1995 (Exhibit 37 to Howard Affidavit)⁴⁸ confirms that Unitherm sells equipment, not processes.⁴⁹ There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).⁵⁰

35. Mr. Mikelberg could not identify what the parameters of that "process" were. (See Swift-Eckrich's Response To Statement No. 28, *supra*.)

⁴⁵ For example, there is no evidence that pre-cooked whole muscle meats were used in these tests. Rather, the data sheet reflects only that "turkey breasts" were used.

⁴⁶ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 35 and 36 to Howard Affidavit as inadmissible hearsay.

⁴⁷ For example, the "capacities" described in the sales proposal to Carolina Turkey compares smoked items with natural browned product. If the product were naturally browned, then no "browning liquid pyrolysis product" would be added. Furthermore, a "smoked" item does not mean that a "browning liquid pyrolysis product" was used.

⁴⁸ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay. Plaintiffs also cite to "pp. 34, 64-65" but do not indicate what these page numbers reference.

⁴⁹ "We have been supplying equipment in the United States for three years;" and "We expect loyalty from them and expect to supply them with innovative labor saving equipment" [U-03462].

⁵⁰ For example, the proposal refers to the application of "liquid smoke," not the application of a "browning liquid pyrolysis product." (See Salm Declaration, ¶¶ 3, 4, attached hereto as Exhibit A.)

36. Unitherm's letter to Mr. Mikelberg dated October 9, 1995 (Exhibit 3 to Mikelberg Depo.) states that Unitherm had "already developed" the "smoke process." (U-03502.)⁵¹ Mr. Mikelberg understood the smoke process to be "heating the product and applying smoke so that the product is - has the smoked appearance and flavor and smell when it comes of out of the process." (Mikelberg Depo., 39:9-14, attached hereto as Exhibit I.) There is no evidence that this "smoke process" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁵² Mr. Singh testified that the October 9, 1995 letter did not reflect his understanding of the trials. (Singh Depo., 172:14-23, attached hereto as Exhibit K.)

37. Swift-Eckrich incorporates by reference its Response To Statement Nos. 28 and 36, *supra*. There is no evidence that this "smoking process" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement Nos. 8, 36, *supra*.)⁵³ Mr. Singh testified that Unitherm merely provided an oven for evaluation to see whether the product could be browned **without** any coating on it. (Singh Depo., 112:13-24; 115:2-6; 118:9-14, attached hereto as Exhibit K.) Unitherm admits that there was an agreement between Unitherm and Swift-Eckrich imposing obligations of confidentiality with respect

⁵¹ The representation by Unitherm in this letter is inadmissible hearsay since Plaintiffs are using this document to show the truth of that representation. For that reason, Swift-Eckrich moves to strike this exhibit.

⁵² For example, the '027 Patent involves a method for browning pre-cooked whole muscle meats, not for "smoking" meats.

⁵³ Plaintiffs also misquote Mr. Mikelberg. The phrase "exactly what David presented to us" (Mikelberg Depo., 49:15, attached hereto as Exhibit I) refers to the abstract and not claim 1 of the '027 Patent. Furthermore, Plaintiffs omit the next sentence uttered by Mr. Mikelberg: "But when I get into the technical aspect of it, you know, I can't compare because I don't have David -what - I don't have David's exact terminologies either." (Mikelberg Depo., 49:17-20.)

to Unitherm's demonstrations. (Howard Depo., 75:15-76:1, attached hereto as Exhibit F; Swift-Eckrich's Response To Statement No. 8, *supra*.)

38. Mr. Howard's letter to Prem Singh dated October 16, 1995 (Exhibit 25 to Singh Depo)⁵⁴ identifies Mr. Howard's "criteria" for trials. Mr. Singh testified that the "criteria" is not the process claimed in the '027 Patent. (Singh Depo., 173:18-24, attached hereto as Exhibit K.)

39. The sales proposals to Swift-Eckrich on April 18, 1996 (Exhibit 27 to Singh Depo) and November 27, 1996 (Exhibit 29 to Singh Depo)⁵⁵ are for the sale of equipment, not a process.⁵⁶ Mr. Singh testified that the "linear smoking process line" is not the same process as claimed in the '027 Patent (Singh Depo., 181:2-19, attached hereto as Exhibit K.)

40. Mr. Singh testified that the process was a "complete failure from the objective that was described to us." (Singh Depo., 118:9-11, attached hereto as Exhibit K.) There is no evidence that the process tested in these confidential trials met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).⁵⁷

41. Mr. Mikelberg testified that during the 13 months that he was President of Swift-Eckrich, he met with Mr. Singh for only 1½ hours. During that time, Mr. Singh did not tell Mr. Mikelberg everything that he had been working on. (Mikelberg Depo., 53:23-54:10, attached

⁵⁴ For the reasons described more fully in footnote 51, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

⁵⁵ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike these exhibits as inadmissible hearsay.

⁵⁶ For example, the drawings sent to Singh on April 25, 1996 (Exhibit 38 to Howard Affidavit) shows a drawing of the different equipment offered for sale. There are no drawings of a "process."

⁵⁷ For example, there is no evidence that this "excellent" product had a "golden brown" color as defined in the '027 Patent.

hereto as Exhibit I.) Mr. Mikelberg was not aware of the work that had been going on at Swift-Eckrich before he arrived. (Mikelberg Depo., 53:15-22.) And, Mr. Mikelberg testified that he did not know what the 100 employees in the research and development department were working on. (Mikelberg Depo., 54:14-55:5.)

42. Unitherm's letter to Mr. Singh dated February 9, 1996 (Exhibit 26 to Singh Depo),⁵⁸ does not state that a "browning process" line is operating at "another client's location." Rather, the "task" performed at "another client's location" is the "application of liquid nitrogen." There is no evidence that the "browning process" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁵⁹

43. Swift-Eckrich incorporates by reference its Response To Statement No. 42.

44. The letter dated November 27, 1996 (Exhibit 29 to Singh Depo)⁶⁰ describes the equipment installed at Unitherm, not a process. There is no evidence that the "Continuous Turkey Smoking and Chilling Line" (which involves smoking and not browning) met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

45. The sales proposals to Plantation Foods on May 2, 1996 (Exhibit 39 to Howard Affidavit), Russer Foods on May 2, 1996 (Exhibit 40 to Howard Affidavit) and Bryan Foods

⁵⁸ For the reasons described more fully in footnote 51, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

⁵⁹ For example, Mr. Howard describes the application of "liquid smoke," not a "browning liquid pyrolysis product."

⁶⁰ For the reasons described more fully in footnote 51, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

on May 2, 1996 (Exhibit 41 to Howard Affidavit)⁶¹ are for the sale of equipment, not a process.⁶²

There is no evidence that a “process” was offered for sale which met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.)⁶³

46. Unitherm’s faxes and letters to various potential customers (Exhibits 42 A-J to the Howard Affidavit),⁶⁴ reflect representations made by Mr. Howard as to the results that can be achieved by his oven. However, Mr. Howard’s representations regarding what his ovens can do are unreliable.⁶⁵ These letters also confirm that Unitherm was interested in selling its RapidFlow oven, not a “process.” See, e.g., Exhibit 42B (“Our RapidFlow II Convection Oven is ideally suited to this operation”). There is no evidence that a “process” was offered for sale which met each of the

⁶¹ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 39-41 to Howard Affidavit as inadmissible hearsay. In addition, there is no indication that Exhibit 41, the proposal to Bryan Foods, was ever sent. Mr. Howard stated under oath that this document was merely a “draft.” (Howard Affidavit, ¶ 43.)

⁶² For example, these proposals refer to “products” and “equipment.” In addition, the “processing line” appears to refer to a line of equipment which processes food.

⁶³ For example, there is no indication that a “browning liquid pyrolysis product” would be applied or that a “golden brown” color would be achieved.

⁶⁴ For the reasons described more fully in footnote 51, *supra*, Swift-Eckrich moves to strike these exhibits as inadmissible hearsay. Furthermore, many of these exhibits have handwritten changes to the letter which may well reflect that these letters were merely drafts and not sent. See Exhibits 42A, 42C and 42I.

⁶⁵ Mr. Howard has made numerous representations that his equipment would accomplish things that it could not. See, e.g., Briggs Depo., 216:13-20, attached hereto as Exhibit L (“in the case of the impingement chiller, I basically was flat telling him that it’s not an impingement chiller . . . this design was, you now, not even close”); 238:3-6 (“when he represented it . . . he truly felt that it would do what it would do. I just don’t think that he really knew”); Singh Depo., 118:9-14, attached hereto as Exhibit K (“it was complete failure from the objective that was described to us [by Howard] . . . that you can brown the product without any coating on it”); Oldja Depo., 20:20-21:5, attached hereto as Exhibit M (hams took twice as long to cook as represented); 27:18-28:16 (radio frequency oven which was promised by Mr. Howard and paid for by Al & John’s was never delivered by Unitherm).

limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁶⁶

47. The sales proposals to Plantation Foods on August 8, 1996 (Exhibit 43A to Howard Affidavit), Jennie-O Foods, Inc. on August 22, 1996 (Exhibit 43B to Howard Affidavit) and Cargill, Inc on August 23, 1996 (Exhibit 43C to Howard Affidavit)⁶⁷ are for the sale of equipment, not a process.⁶⁸ There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁶⁹

48. The video attached as Exhibit 83 to the Howard Affidavit is inadmissible because it has not been properly authenticated.⁷⁰ There is no evidence that the process demonstrated for Hudson Foods on September 12, 1996 met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.) This demonstration was performed pursuant to a confidentiality agreement. (Howard Depo., 65:18-67:4, attached hereto as Exhibit F; *see also* Swift-Eckrich's Response To Statement No. 8, *supra*.)

⁶⁶ For example, the faxes do not report parameters of a "process" only the result achieved. In fact, the only unmarked exhibit which claims the attainment of a golden brown color (which has not been objectively measured) refers to "ham smoking requirements." (Exhibit 42D.) There is no evidence that the liquid smoke product being used was a "browning liquid pyrolysis product."

⁶⁷ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 43A-43C to Howard Affidavit as inadmissible hearsay.

⁶⁸ For example, these exhibits all refer to the "enclosed equipment layout."

⁶⁹ For example, there is no evidence that a "browning liquid pyrolysis product" is used **or** that a "golden brown" color is achieved.

⁷⁰ For the reasons described more fully in footnote 3, *supra*, Swift-Eckrich moves to strike Exhibit 83.

49. The trial data sheets for Hudson Foods (Exhibit 4 to Briggs Depo) have not been properly authenticated and are inadmissible hearsay.⁷¹ Not only were these tests performed pursuant to a confidentiality agreement, but there is no evidence that the tests being demonstrated met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁷²

50. The sales proposal to Hudson Foods on September 13, 1996 (Exhibit 3 to Briggs Depo., WB 22-26)⁷³ is for the sale of equipment, not a process. Mr. Briggs testified that Hudson Foods purchased an oven from Unitherm, not a process. (Briggs Depo., 113:9-13; 160:19-161:3; 164:10-17, attached hereto as Exhibit L.) There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁷⁴

51. There is no evidence that the "Radiant Wall Oven process" developed by Hudson Foods (Exhibit 3 to Briggs Depo., WB-18) met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁷⁵ Mr. Briggs is not qualified to testify about the process claimed in the '027 Patent or

⁷¹ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these documents.

⁷² For example, only Product Nos. 76 or 50076 (U-05587-88) appear to involve the application of Maillose. Yet, there is no evidence that a "golden brown" color was produced. In addition, there is no evidence that pre-cooked whole muscle meats were being tested.

⁷³ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

⁷⁴ For example, there is no evidence that a "browning liquid pyrolysis product" is used or that a "golden brown" color is achieved.

⁷⁵ For example, the temperatures of the oven for this process was 1150° to 1200°, significantly higher than the temperatures claimed in the '027 Patent. In addition, there is no evidence that the "smoke" being applied was a liquid browning pyrolysis product or that a "golden brown" product was produced.

how that process compared to any process used by Hudson.⁷⁶ Mr. Briggs testified that he expected that his "process" would be kept confidential. (Briggs Depo., 208:10-210:13, attached hereto as Exhibit L.)

52. The Hudson Foods data comparison dated September 19, 1996 (Exhibit 3 to Briggs Depo., WB-27) has not been properly authenticated and is inadmissible hearsay.⁷⁷ There is no evidence that the tests met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)⁷⁸ There is no evidence that "SD" means, as Plaintiffs claim, "Smoke deposit (pick-up) amounts for these runs."⁷⁹

53. Hudson Foods purchased equipment, not a process, from Unitherm. See Exhibit 3 to Briggs Depo., WB 28-32 (sales proposal for equipment); WB 40 (a purchase requisition

⁷⁶ Mr. Briggs testified that (a) he was not an attorney or an engineer (Briggs Depo., 142:8-14, attached hereto as Exhibit L); (b) he did not know what pyrolysis or a pyrolysis browning agent is (*Id.*, 142:15-143:2); (c) the '027 Patent was the first patent he had ever read (*Id.*, 143:3-15); (d) he did not know the percentage amount of pickup of the browning liquid pyrolysis product used by Hudson (*Id.*, 196:19-23); (e) he did not know whether Hudson used a browning liquid pyrolysis product which contained a masking agent or flavoring enhancing composition (*Id.*, 196:24-197:3); (f) he did not know whether Hudson used a browning liquid pyrolysis product which contained turkey flavor, turkey broth or a mixture of the two (*Id.*, 197:4-8); (g) he did not know the oven temperature ranges used by Hudson (*Id.*, 198:16-199:3); and (h) he did not know the temperature at the core of the product both before and after Hudson placed product in the oven. (*Id.*, 206:12-15.)

⁷⁷ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these documents.

⁷⁸ For example, there is no evidence that a "golden brown" color was produced. In fact, this data comparison states that "[s]ubjective color and taste evaluation need to be conducted on products tested." (WB 27.)

⁷⁹ Again, only Product No. 50076 involved the application of Maillose. There is no evidence that the "smoke" applied to the other products were "browning liquid pyrolysis products."

for equipment); and WB 41 (“[w]e have a lot of activity going on with the Unitherm Oven installation”). See also Briggs Depo., 113:9-13; 160:19-161:3; 164:10-17, attached hereto as Exhibit L. The handwritten results of these alleged “start-up” tests (Exhibit 3 to Briggs Depo., WB 80-85) have not been properly authenticated and are inadmissible hearsay.⁸⁰ There is no evidence that these confidential “start-up tests at Hudson on February 24 and 25, 1997” met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.)⁸¹ There is no evidence that the “process description” filed with the USDA (Exhibit 3 to Briggs Depo., WB 92-94) met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.)⁸²

54. Prior to May 11, 1997, Hudson produced, sold and shipped Hudson product Nos. 50044, 50088 and 50304. (Exhibit 3 to Briggs Depo., WB 110-119.)⁸³ There is no evidence that these products were produced using a process which met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.) For example, there is no evidence that these three products used Maillose

⁸⁰ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these documents.

⁸¹ For example, these documents do not reflect that pre-cooked whole muscle meats were tested. Also, only one “start-up” test included the use of a “browning liquid pyrolysis product” (i.e. Maillose) - Product No. 50076. (WB-85.) All of the other tests involve some type of “smoke” solution which may not have been a “browning liquid pyrolysis product.” Finally, since no L, A, and B value, or any other objective color value, was measured there is no evidence that (a) a “golden brown” color was produced or (b) the subjective evaluation of Product No. 50076 (“golden brown with black highlights”) comports with the claims of the ‘027 Patent.

⁸² For example, there is no evidence that a “browning liquid pyrolysis product” would be used or a “golden brown” color would result from these procedures.

⁸³ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike these exhibits as inadmissible hearsay.

or some other browning liquid pyrolysis product. Hudson Product Nos. 50044 (Gourmet Recipe Honey Mesquite Smoked), 50088 (Gourmet Recipe Cajun), 50304 (Deluxe Skinless Smoked) are **smoked, not browned** products. (Exhibit 3 to Briggs Depo., WB-34.)⁸⁴ (See Swift-Eckrich's Response To Statement No. 2, *supra*.)⁸⁵ There is no evidence that any product sold by Hudson Foods prior to May 11, 1997 had a "golden brown" color as claimed in the '027 Patent.

55. Any collaboration between Unitherm and Hudson Foods was under the guise of confidentiality. (Howard Depo., 65:18-67:4, attached hereto as Exhibit F; see also Swift-Eckrich's Response To Statement Nos. 8 and 51, *supra*.)⁸⁶

56. Jeff Dierenfeld testified that Maillose was not used in this 1996 demonstration. (Dierenfeld Depo., 17:24-18:2, attached hereto as Exhibit N.) He also testified that he did not know the concentration of the liquid smoke that was applied (*id.*, 16:25-17:1) or even whether pyrolysis products were used. (*Id.*, 18:5-11.) Mr. Dierenfeld testified that Mr. Howard did not explain to him in detail what the process was. (*Id.*, 14:3-8.) Any demonstration performed for Jennie-O or Jeff Dierenfeld was pursuant to a confidentiality agreement. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

⁸⁴ The handwritten "Unitherm Operating Conditions" for Product Nos. 50044 and 50304 show only that a "smoke" solution (sometimes combined with water or 10DC) was used. See WB 81, 84. There is no evidence of the type of solution that was used on Product No. 50088.

⁸⁵ Only Product Nos. 50086 (Gourmet Recipe Italian Herb), 50076 (Prestige Select Natural Restaurant Oil Browned) and 57988 (Prestige Deli Cajun Caramel Browned) used Maillose. There is no evidence that Product Nos. 50086, 50076 or 57988 were sold on or before May 11, 1997.

⁸⁶ Mr. Howard states in his affidavit that Hickory Foods witnessed demonstrations of the Unitherm process but did not execute any type of confidentiality agreement with Unitherm. (Howard Affidavit, ¶ 47.) Mr. Howard does not state what Hickory Foods witnessed or when. Mr. Howard testified, however, that (a) all the companies to whom Unitherm was demonstrating the process had confidentiality agreements (Howard Depo., 68:21-69:14, attached hereto as Exhibit F); and (b) he was not aware of anyone who had been disclosed the process that was not under an obligation of secrecy to Unitherm. (Howard Depo., 317:1-23.)

57. The results of the alleged test ran by Unitherm for Jennie-O in 1996 (Exhibit 3 to Woods Depo., U-02284) is inadmissible hearsay.⁸⁷ There is no evidence that the process tested, pursuant to a confidentiality agreement, met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, supra.)⁸⁸

58. The photographs appended to the Dierenfeld Declaration were taken in 2002. They cannot be used to show that product produced in 1997 was "golden brown" as that term is defined in the '027 Patent. (See Civille Decl., ¶¶ 3, 4, attached hereto as Exhibit B.) Swift-Eckrich incorporates by reference its Response To Statement Nos. 56 and 57, supra.

59. The February 14, 1997 memorandum by Mr. Dierenfeld (Exhibit 6 to Wood Depo) has not been authenticated and is inadmissible hearsay.⁸⁹ Furthermore, there is no evidence that the tests by Unitherm, which were confidential, met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, supra.)⁹⁰

60. Mr. Wood did not testify that Jennie-O purchased a "process" from Unitherm. He merely stated that "Unitherm had a process." (Wood Depo., 22:8, attached hereto as Exhibit O.)

⁸⁷ For the reasons described more fully in footnote 6, supra, Swift-Eckrich moves to strike this exhibit.

⁸⁸ For example, there is no evidence that the liquid smoke used (Charcoal Select) is a "browning liquid pyrolysis product" as claimed in the '027 Patent or that a "golden brown" color was achieved.

⁸⁹ For the reasons described more fully in footnotes 5, 6 and 8, supra, Swift-Eckrich moves to strike this exhibit.

⁹⁰ For example, there is no evidence that a "golden brown" color was achieved as that term is defined in the '027 Patent. In fact, this memorandum states that the "test units range from the light end of the spec to the dark". There is also no evidence that a "browning liquid pyrolysis product" was used.

Jennie-O purchased equipment from Unitherm, not a process. See Exhibit 43B to Howard Affidavit (“Please refer to the full-size layout for locations and sizing of this equipment”). There is no evidence that the “process” met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.)⁹¹

61. The “quote” sent by Unitherm to Jennie-O (Exhibit 7 to Wood Depo)⁹² is for the sale of equipment, not a process. (See Swift-Eckrich’s Response To Statement No. 60, *supra*.) In fact, the quote describes “**your** in-line smoking process” which would indicate Jennie-O’s process, not Unitherm’s. There is no evidence that a “process” was offered for sale which met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement Nos. 8 and 60, *supra*.)

62. The sales proposals to Plantation Foods on September 26, 1996 (Exhibit 46 to Howard Affidavit) and Swift-Eckrich on August 30, 1996 (Exhibit 45 to Howard Affidavit)⁹³ are for the sale of equipment, not a process.⁹⁴ There is no evidence that a “process” was offered for sale which met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*).⁹⁵

⁹¹ For example, Mr. Wood refers to the application of “liquid smoke,” not a “browning liquid pyrolysis product.” Nor did Mr. Wood testify that this “process” resulted in a “golden brown” color.

⁹² For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

⁹³ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike Exhibits 45 and 46 to Howard Affidavit as inadmissible hearsay.

⁹⁴ These exhibits refer to the “sizing of this equipment” or “a list of equipment.”

⁹⁵ For example, there is no evidence of the use of a “browning liquid pyrolysis product” or a “golden brown” color being achieved.

63. The sales proposals to Wilson's Continental Deli Foods on October 10, 1996; Jennie-O Foods on December 31, 1996; Foster Farms on November 14, 1996; Butterball Turkey on November 21, 1996; Cargill, Inc. on November 26, 1996; Jennie-O Foods on December 3, 1996; Swift-Eckrich on December 26, 1996; Bryan Foods on December 19, 1996; Bryan Foods on December 31, 1996; International Trading Co. on January 13, 1997; Farmland Foods on January 14, 1997; Perdue Farms on February 12, 1997; Foster Farms on April 17, 1997; and Foster Foods on April 10, 1997 (Exhibits 47-48, 50-58, 61 and 64-65, respectively, to Howard Affidavit)⁹⁶ are for the sale of equipment, not a process. There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement Nos. 8 and 62, *supra*.)

64. The fax from Unitherm to Foster Farms on November 5, 1996 (Exhibit 49 to Howard Affidavit) is inadmissible hearsay.⁹⁷ There is no evidence that the confidential "Unitherm process" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*).⁹⁸

65. Unitherm supposedly sent faxes to approximately 200 individuals inviting them to visit the Unitherm booth at a trade show in Atlanta in January 1997 saying that Unitherm will be showing its "in-line browning/smoking system." (Exhibit 59 to Howard Affidavit).⁹⁹ Yet,

⁹⁶ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike these exhibits as inadmissible hearsay.

⁹⁷ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

⁹⁸ For example, although Unitherm apparently applied liquid smoke to a product of Foster Farms, there is no evidence that the liquid smoke used (Charcoal Select or smoke) is a browning liquid pyrolysis product.

⁹⁹ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

Mr. Howard testified that, from 1993 to 1999, he demonstrated the RapidFlow oven in a process that used liquid smoke **only once** at a trade show. (Howard Depo., 100:6-19; and 101:23-102:4, attached hereto as Exhibit F.)¹⁰⁰ And, that one demonstration occurred for one unknown customer after the trade show had finished. (Howard Depo., 101:2-17.) There is no evidence that the “process” demonstrated, or referred to in these faxes, met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, *supra*.) Unitherm has admitted that any demonstration of the Unitherm “process” at any trade show before May 11, 1998 was on a confidential basis. (Unitherm Response to Request For Admission No. 16, attached hereto as Exhibit E.)

66. Mr. Singh testified that Mr. Howard never told him that the “in-line browning/smoking system” was the same as the process which is now claimed in the ‘027 Patent (Singh Depo., 186:18-187:1, attached hereto as Exhibit K.) Mr. Singh could not tell whether the system was the same as the process claimed in the ‘027 Patent. (Singh Depo., 186:7-17.)

67. The data sheets for Perdue, Plainville and Wilson on February 7, 1997 (Exhibit 60 to Howard Affidavit) have not been properly authenticated and are inadmissible hearsay.¹⁰¹ Not only were these tests performed pursuant to a confidentiality agreement, but there is no evidence that the tests being demonstrated met each of the limitations of the claims of the

¹⁰⁰ Mr. Howard testified that this demonstration occurred at the Georgia World Congress Poultry Exhibition in Atlanta. (Howard Depo., 100:16-19, attached hereto as Exhibit F.) It is unclear whether this Poultry Exhibition is the same trade show as the International Poultry Exposition which is referenced in Exhibit 59 to the Howard Affidavit.

¹⁰¹ For the reasons described more fully in footnotes 5, 6 and 8, *supra*, Swift-Eckrich moves to strike these documents.

`027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹⁰²

68. The sales proposals to Perdue on February 12, 1997 (Exhibit 61 to Howard Affidavit)¹⁰³ are for the sale of equipment, not a process. There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the `027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹⁰⁴

69. The purchase order from Plantation Foods dated February 7, 1997 (Exhibit 62 to Howard Affidavit)¹⁰⁵ is for the sale of equipment, not a process. There is no evidence that a "process" was offered for sale which met each of the limitations of the claims of the `027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

70. Mr. Howard's letter to Swift-Eckrich on April 21, 1997 that Unitherm had "sold the process to four companies" (Exhibits 66 and 67 to the Howard Affidavit) is inadmissible hearsay.¹⁰⁶ Mr. Howard does not identify what that "process" was. In fact, the only "process" which Unitherm showed Swift-Eckrich was its representation that it could brown product in its oven

¹⁰² For example, there is no evidence that a "golden brown" color was achieved.

¹⁰³ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike these exhibits as inadmissible hearsay.

¹⁰⁴ For example, Unitherm writes that one could "dial in the degree of color you require." This does not mean a "golden brown" color as that is defined by the `027 Patent. Furthermore, even if Mr. Howard opined that he could achieve such a color, there is no evidence to show that he actually carried out a process that would do so or that he actually did achieve such a color. See footnote 65, *supra*. In addition, the `027 Patent refers to a browning, not a "smoking" process.

¹⁰⁵ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

¹⁰⁶ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

without using any browning agent (which was a complete failure). Singh Depo., 118:9-14, attached hereto as Exhibit K. There is no evidence that Unitherm ever sold a “process,” as opposed to equipment, to anyone. There is also no evidence that the “process” allegedly sold by Unitherm met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, supra.)

71. The purchase order from Foster Farms dated May 2, 1997 (Exhibit 68 to Howard Affidavit)¹⁰⁷ is for the sale of equipment, not a process. There is no evidence that a “process” was offered for sale which met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. (See Swift-Eckrich’s Response To Statement No. 8, supra.)

72. With respect to Swift-Eckrich’s experiments with Unitherm’s equipment in February 1998, Chris Salm testified that the product initially achieved a golden brown color.¹⁰⁸ However, the color “faded over time, and some of it developed a green ring under the surface.” (Salm Depo., 106:4-12, attached hereto as Exhibit P.) (See Swift-Eckrich’s Response To Statement No. 48, supra.)

73. The sales proposals to Swift-Eckrich on February 24, 1998 (Exhibit 71 to Howard Affidavit), Perdue Farms on December 31, 1997 (Exhibit 72 to Howard Affidavit) and Cargill, Inc. on March 3, 1998 (Exhibit 73 to Howard Affidavit)¹⁰⁹ are for the sale of equipment, not a process. There is no evidence that a “process” was offered for sale which met each of the

¹⁰⁷ For the reasons described more fully in footnote 8, supra, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

¹⁰⁸ Plaintiffs misstate Mr. Salm’s testimony. Mr. Salm did not state that “Unitherm produced product meeting Defendant’s golden brown color objective.” Rather, Swift-Eckrich’s experimentation with a Unitherm oven resulted, **initially**, in such a color.

¹⁰⁹ For the reasons described more fully in footnote 8, supra, Swift-Eckrich moves to strike Exhibits 71-73 to Howard Affidavit as inadmissible hearsay.

limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)¹¹⁰

74. Unitherm contends that the demonstrations which it performed were secret. There is no credible evidence that Swift-Eckrich was aware of any of these demonstrations. Furthermore, there is no credible evidence that Unitherm's "activities" met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.) Finally, the '027 Patent describes related art which appears to include the "process" which Unitherm claims it developed. ('027 Patent, Col 1, line 27-Col 2, line 36.)

75. Mr. Howard's letter to Roy Cantu dated June 1, 1998 (Exhibit 75 to Howard Affidavit) is inadmissible hearsay.¹¹¹ There is no evidence that the "in-line browning and smoking process" referred to in his letter met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

76. Mr. Howard's letter to Jeffrey Craft dated August 20, 1998 (Exhibit 76 to Howard Affidavit) is inadmissible hearsay.¹¹² Mr. Singh testified that Unitherm provided an oven to Swift-Eckrich in 1995 to test whether it could naturally brown product. (Singh Depo, 118:9-14, attached hereto as Exhibit K.) Mr. Howard's statement that Unitherm introduced an in-line smoking

¹¹⁰ In fact, the sales proposals refers to "your Browning/Smoking line" which would indicate a "line" of Unitherm's customers, not Unitherm's. In addition, as described more fully in footnote 104, *supra*, Mr. Howard's representation that one could "dial in the degree of color you require" does not mean that (a) a "golden brown" color could be achieved or (b) his representation is reliable.

¹¹¹ For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

¹¹² For the reasons described more fully in footnote 8, *supra*, Swift-Eckrich moves to strike this exhibit as inadmissible hearsay.

and roasting system to Swift-Eckrich in 1995 contradicts Plaintiffs' claims (Plaintiffs' Statements 22-24, 26) that this allegedly occurred in 1993.

77. Swift-Eckrich does not dispute this Statement of Facts.

78. Mr. Singh is not a lawyer, nor is he an expert on what is or what is not patentable. Therefore, his understanding of patent law is irrelevant.

79. Swift-Eckrich does not dispute this Statement of Facts.

80. Swift-Eckrich does not dispute this Statement of Facts.

81. Mr. Singh's testimony describes the Process Flow Sheet attached as Exhibit 2 to his deposition and the process that occurred in 1988 or 1989. However, Plaintiffs do not completely and accurately identify all of the steps of this Flow Sheet to which Mr. Singh testified.

82. Mr. Singh testified that Swift-Eckrich produced product in the Enercyst oven using a caramel solution, not a liquid pyrolysis product. Further, Mr. Singh testified that a golden brown color was not obtained. Finally, Mr. Singh testified that the process used in the Enercyst system was not the same as the process claimed in the '027 Patent. (Singh Depo., 77:13-24; 82:8-23; and 84:19-24, attached hereto as Exhibit K.)

83. Mr. Singh testified that he did not tell the Patent and Trademark Office about the Enercyst system because it was another conventional process. (Singh Depo., 91:20-23, Exhibit K.) See Swift-Eckrich's Response To Statement No. 82, *supra*.

84. Maillose is a browning liquid pyrolysis product. Caramel agents or solutions are a non-pyrolysis product. A pyrolysis product creates a Maillard reaction. A caramel agent or solution does not; rather, it is just a dye. (Singh Depo., 82:8-23, attached hereto as Exhibit K.) Red Arrow confirms this fact. "Development takes place basically through the Maillard reaction **and is not a pre-reacted color like caramel.**" (Appendix U.) Furthermore, Maillose is considered

“caramel coloring” only for labeling purposes by the USDA.¹¹³ The Enercyst system used a caramel solution and not a browning liquid pyrolysis product as required by all claims of the ‘027 Patent.

85. Mr. Hussain carried out the process in 1993 on an experimental basis. This occurred after Mr. Singh invented the process. (Singh Depo., 55:19-23, attached hereto as Exhibit K.)

86. Mr. Hussain testified that he did not know whether the product was sold to the public. (Hussain Depo., 93:22-94:20, attached hereto as Exhibit G.) Mr. Singh testified Swift-Eckrich did not use Maillose for the production of products (e.g., to be sold to the public). (Singh Depo., 98:12-15; 99:16-19, attached hereto as Exhibit K.) Rather, they both testified that this was an experiment. (Hussain Depo., 93:10-12; 94:18-20; Singh Depo., 97:5-14; 99:16-100:1; 101:22-102:24; 103:13-18.) The products were given UPC codes as a precaution, so that they could be sold in the event that the experiment was so successful that a permanent change in the process was made. However, no such change was made at that time and the plant went back to using the old caramel process (a non-pyrolysis product). There is no evidence that any such product made in the course of the experiment was sold - only that labels were changed.

87. Swift-Eckrich incorporates by reference its Response To Statement No. 86.

88. Swift-Eckrich does not dispute this Statement of Facts.

89. Swift-Eckrich does not dispute this Statement of Facts.

90. Plaintiffs rely on Mr. Howard’s deposition (pp. 230-233) to support its claim that 13 companies have purchased the Unitherm “process.” However, Mr. Howard testified only that these companies purchased the RapidFlow oven. (Howard Depo., 233:5-19, attached hereto as

¹¹³ The Food Standards and Labeling Policy Book of the USDA identifies “caramel coloring” as providing artificial, as opposed to natural, coloring.

Exhibit F.) There is no description of what the "Unitherm process" is and whether it met each of the limitations of the claims of the '027 Patent and thus embodied the claimed invention. (See Swift-Eckrich's Response To Statement No. 8, *supra*.)

91. Swift-Eckrich has made an offer of license limited to those parties who have not infringed the '027 Patent by using the process, but wish to use the process in the future. (Exhibit 5 to Salm Depo, attached hereto as Exhibit Q.)

III. ANALYSIS

A. PLAINTIFFS MUST PROVE THE '027 PATENT INVALID BY CLEAR AND CONVINCING EVIDENCE.

Invalidity under 35 U.S.C. § 102(b) must be proven by clear and convincing evidence.

Allied Colloids, Inc. v. Am. Cyanamid Co., 64 F.3d 1570, 1574 (Fed. Cir. 1995). This heavy burden of proof remains throughout the trial on the party asserting invalidity. TP Labs., Inc. v. Prof'l Positioners, Inc., 724 F.2d 965, 972 (Fed. Cir. 1984) cert. denied, 469 U.S. 826 (1984) ("we see no reason why the legal burden of proof should shift, and we know of no authoritative and considered decision to that effect").

Plaintiffs cannot succeed on their motion for summary judgment because they have not shown, by clear and convincing evidence,¹¹⁴ that the demonstrations performed by Unitherm were public (i.e., not performed pursuant to a confidentiality agreement). In addition, Plaintiffs cannot succeed on their motion because they have not shown, by clear and convincing evidence, that

¹¹⁴ As more fully detailed in Swift-Eckrich's Responses To Statement Of Material Facts, *supra*, the exhibits and evidence upon which Plaintiffs seek to support their Motion are inadmissible and should be stricken. Therefore, Plaintiffs' Motion should be denied because there is no evidence, let alone clear and convincing evidence, of invalidity or unenforceability.

the “Unitherm process” meets each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention.

B. UNITHERM DEMONSTRATED THE “PROCESS” PURSUANT TO AGREEMENTS OF CONFIDENTIALITY AND SECRECY.

Plaintiffs claim that they, not Swift-Eckrich,¹¹⁵ placed the invention in public use by the numerous demonstrations which Unitherm made of the “Unitherm process” to potential customers in the United States.¹¹⁶ (Plaintiffs’ Motion, pp. 26, 31-32.) However, when the asserted prior use is not that of the patentee, “third party secret commercial activity, more than one year before the patent application of another, is **not a § 102(b) bar.**” Woodland Trust v. Flowertree Nursery, 148 F.3d 1368, 1371 (Fed. Cir. 1998) (emphasis added). See also Oddzon Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1402 (Fed. Cir. 1997) (“When the possessor of secret prior art (art that has been abandoned, suppressed, or concealed) that predates the critical date is faced with a later-filed patent, the later-filed patent should not be invalidated in the face of this ‘prior’ art, which has not been made available to the public. Thus, prior, but non-public, inventors yield to later inventors who utilize the patent system”).

Both the Federal Circuit and the Supreme Court have defined “public use” as use of the claimed invention with “no limitation, restriction or obligation of secrecy.” In re Smith, 714 F.2d 1127, 1134 (Fed. Cir. 1983), citing Egbert v. Lippmann, 104 U.S. 333, 336 (1881). The existence of

¹¹⁵ Swift-Eckrich’s experimental use with its process do not constitute a public use bar pursuant to 35 U.S.C. § 102(b). Allied Colloids, 64 F.3d at 1576 (“A public use under § 102(b) does not start the one-year period until the invention has left the experimental stage”).

¹¹⁶ Plaintiffs improperly rely on a demonstration in the United Kingdom to Paul Corrigan. (Plaintiffs’ Statement of Fact No. 7.) However, the “public use” statutory bar requires such use to occur in the United States. 35 U.S.C. § 102(b) (“the invention was . . . in public use or on sale **in this country** more than one year prior to the date of the application for patent in the United States”) (emphasis added.).

confidentiality agreements¹¹⁷ negate Plaintiffs' contention that the use was "public." TP Labs., Inc. v. Prof'l Positioners, Inc., 724 F.2d 965, 972 (Fed. Cir. 1984), cert. denied, 469 U.S. 826 (1984) (confidentiality agreements indicate control and are evidence against public use); Allied Colloids, Inc., 64 F.3d at 1574 (considering "whether there was any confidentiality obligation imposed on persons who observed the use"); AMP, Inc. v. Fujitsu Microelectronics, 853 F. Supp. 808, 816 (M.D. Pa. 1994) (the existence of confidentiality agreements "weighs heavily against" a finding of public use); Articulate Sys., Inc. v. Apple Computer, Inc., 53 F. Supp. 2d 62, 76 (D. Mass. 1999) (relinquishing control and the existence of secrecy agreements "appear to carry the most weight" of the public use factors¹¹⁸ to be considered).

Plaintiffs cannot show, by clear and convincing evidence, that the '027 Patent was in "public" use, because they have admitted that all of the alleged demonstrations of the "Unitherm process" were performed pursuant to agreements of confidentiality and secrecy. Plaintiffs, by their denials of Requests for Admission, have impliedly conceded that, before "May 11, 1998, Plaintiff

¹¹⁷ In Moleculon Research Corp. v. CBS, Inc., the court found that, even without explicit confidentiality agreements, use was not public when the user "at all times retained control over its use as well as over the distribution of information concerning it." 594 F. Supp. 1420, 1427 (D. Del. 1984), aff'd 793 F.2d 1261 (Fed. Cir. 1986), cert. denied, 479 U.S. 1030 (1987), on remand, 666 F. Supp. 661 (D. Del. 1987), rev'd on other grounds, 872 F.2d 407 (Fed. Cir. 1989).

¹¹⁸ Most courts apply the "totality of the circumstances" test, requiring consideration of a variety of factors to determine whether there has been a public use under § 102(b). However, the Supreme Court has suggested in Pfaff v. Wells Elecs., 525 U.S. 55 (1998), that the public use provision identifies "an interest in providing inventors with a definite standard for determining when a patent application must be filed." Id. at 65. In light of this interest, the Federal Circuit has abandoned a similar "totality of circumstances" test for the on-sale bar of § 102(b). See, e.g., Weatherchem Corp. v. J. L. Clark, Inc., 163 F.3d 1326, 1333 (Fed. Cir. 1998) ("the Supreme Court counseled against the multifactor "totality of the circumstances" test as a trigger for the on-sale bar, crediting this court for criticizing such a trigger "as unnecessarily vague"). In light of this treatment of § 102(b), public use analysis should be approached with an eye to a standard by which the inventor would *know* when a patent must be filed, rather than a set of indefinite circumstances.

Unitherm [did not disclose] the process that it refers in the Complaint as the ‘Unitherm browning/smoking process’,¹¹⁹ to potential customers for its ovens **without obtaining from those potential customers agreements to keep that process secret.**” (Plaintiffs’ Response to Request For Admission No. 13, attached hereto as Exhibit E) (emphasis added).)¹²⁰

David Howard confirmed the existence of these agreements at his deposition:

A: As I introduced Unitherm to all visitors that came to the facility, they were brought to the boardroom. They were given a short history of Unitherm. And then they were told in that speech that Unitherm was an innovative company and that there are trade secrets that are specifically ours and we ask them to respect that.

(Howard Depo., 66:23-67:2, attached hereto as Exhibit F.)

Q: Now, did those 20 companies¹²¹ sign agreements to keep that process confidential?

A: I believe that they did sign confidentiality agreements.

Q: All of them?

A: I - I believe so.

(Howard Depo., 69:10-14, attached hereto as Exhibit F.)

¹¹⁹ Plaintiffs define the “Unitherm in-line browning/smoking process” as the subject matter now claimed in the ‘027 Patent. (First Amended Complaint, ¶ 11, attached hereto as Exhibit H.)

¹²⁰ See also Plaintiffs’ Response to Request For Admission Nos. 9-11, attached hereto as Exhibit E (conceding agreements imposing obligations of confidentiality on Swift-Eckrich); 12 (conceding agreement imposing obligation of confidentiality on Red Arrow); 14 (conceding agreement with Jennie-O to keep process secret); 15 (conceding agreements with its employees to keep process secret); 16 (conceding confidential demonstrations at trade shows); 17 (conceding agreement with Thorn Apple Valley to keep process secret); and 18 (conceding marking sales materials, proposals and correspondence sent to potential customers to show that they were confidential or secret); Unitherm’s Response to Interrogatory No. 4, attached hereto as Exhibit C (identifying confidentiality agreements which Unitherm had entered into relating to “Unitherm’s browning/smoking process”).

¹²¹ Mr. Howard testified that between 1993 and 1997 he made 20 demonstrations of the “Unitherm process” to potential customers. (Howard Depo., 68:16-23, Exhibit F.)

A: Anyone that visited Unitherm, be it Red Arrow or Armour Swift-Eckrich or any client, we told them that there are secrets that are Unitherm's and we intent - we expect them to keep them secret.

(Howard Depo., 110:12-15, attached hereto as Exhibit F.)¹²²

Given the existence of these confidentiality agreements, Plaintiffs cannot show, by clear and convincing evidence, that Unitherm's demonstrations (or videos) of the "Unitherm process" were a "public use" under 35 U.S.C. § 102(b).

C. THE "UNITHERM PROCESS" DOES NOT MEET EACH OF THE LIMITATIONS OF THE CLAIMS IN THE '027 PATENT.

Plaintiffs have not shown that the "Unitherm process" is the same process claimed in the '027 Patent. A party asserting invalidity under 35 U.S.C. § 102(b) must establish, by clear and convincing evidence, that "the subject of the barring activity met each of the limitations of the claim, and thus was an embodiment of the claimed invention." Scaltech, Inc. v. Retec/Tetra L.L.C., 178 F.3d 1378, 1383 (Fed. Cir. 1999). See PPG Indus. v. Guardian Indus., Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996) ("to anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter"); Ferag AG v. Grapha-Holding AG, 905 F. Supp. 1, 6 (D. D.C. 1995) ("if even a single element or limitation required by the claim is missing from the disclosure of the reference, there can be no anticipation").

¹²² See also Howard Depo., 65:18-67:4, attached hereto as Exhibit F (agreement with Hudson Foods to keep process secret); 75:12-76:1 (agreement with Swift-Eckrich to keep process secret); 91:2-13 and 93:5-94:9 (agreement with Thorn Apple Valley to keep process secret); 111:23-112:5 (agreement with Red Arrow to keep process secret); and 317:1-21 (Mr. Howard could not identify any one, other than the people to whom Unitherm had disclosed the "process" under pledges of secrecy and confidentiality, that knew how to carry out the "process").

Anticipation under 35 U.S.C. § 102, including whether or not an element is inherent in the prior art, is a question of fact. See *Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999). Therefore, a party asserting invalidity under § 102 has a “high burden” to overcome. Union Oil Co. of Cal. v. Atl. Richfield Co., 208 F.3d 989, 994-995 (Fed. Cir. 2000), cert. denied, 121 S. Ct. 1167 (2001). This burden is particularly high in the context of a summary judgment motion, where the movant must show by clear and convincing evidence that there is *no* genuine issue of material fact. See Fed. R. Civ. P. 56; Allied Colloids, 64 F.3d at 1574-1575 (judgment granted only if “there can be but one reasonable conclusion as to the verdict”).¹²³

Furthermore, “a court may not invalidate the claims of a patent without construing the disputed limitations of the claims and applying them to the allegedly invalidating acts.” Dana Corp. v. Am. Axle & Mfg., Inc., 279 F.3d 1372, 1376 (Fed. Cir. 2002). The court should “consider the parties’ arguments concerning the invalidity of all of the claims, construe the relevant limitations of the claims, and evaluate if there are genuine issues of material fact as to whether those limitations are met by the subjects of the alleged bars.” Id. at 1377. Each independent and dependent claim must be construed because each claim is presumed independently valid, even when a dependent claim is dependent on an invalid claim. See 35 U.S.C. § 282.

¹²³ “Credibility determinations, the weighing of evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict. The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.” Allied Colloids, 64 F.3d at 1575. In this Response, Swift-Eckrich has challenged the credibility of Mr. Howard, Mrs. Howard, Unitherm, Mr. Corrigan, Mr. Mikelberg, Mr. Briggs, and Mr. Dierenfeld. (See Swift-Eckrich’s Response To Statement Nos. 3, 7, 13, 28, 41, 51, 56, and 58; and footnotes 2, 16, 37, 65, and 76, *supra*). When a witness’ credibility is properly challenged, that testimony cannot be used to support summary judgment. Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1191 (9th Cir. 2002).

Claim construction determinations are critical because they shape the validity (and infringement) positions of the parties, and are “the central issues of nearly every patent appeal.” Minco, Inc. v. Combustion Eng’g, Inc., 95 F.3d 1109, 1114 (Fed. Cir. 1996). Plaintiffs have not even attempted to construe the claims of the ‘027 patent, as is required for a judgment of invalidity, and have offered merely conclusory statements regarding the comparison between any alleged barring activities and the elements of the claims.

For example, Plaintiffs’ attempt to construe the term “golden brown” found in the ‘027 Patent is inadequate, misleading and unreliable.¹²⁴ In addition, Plaintiffs dispute that a determination of “golden brown” under the ‘027 Patent necessitates a Hunter-Lab Color Meter measurement of the L, A and B values of that product. (Plaintiffs’ Motion, p. 3, fn. 3.)¹²⁵ By

¹²⁴ Plaintiffs rely on video pictures, photographs, computer printouts or visual observation (without measurements) to show a “golden brown” color. (See Exhibits 1A-F, 12A-G, 14A-H, 44A-F, 70A-I, 80, 81, 82, 83 and 84 to Howard Affidavit; Appendices V and Z; Howard Affidavit, ¶¶ 2, 4, 18, 20, 21 and 46; Dierenfeld Affidavit, ¶¶ 1, 2; Exhibit 1 to Dierenfeld Affidavit; Plaintiffs’ Statement of Material Facts, Nos. 2, 3, 7, 8, 18, 19, 46, 53, 58, 84, 85 and 86.) However, the colors represented in color photographs or videotapes or computer screens are not reliably representative of the actual object. Given the different color settings available on computers, printers, photolabs and photographic equipment, as well as differences in light and film, the colors represented in such pictures or printouts cannot accurately reflect the color of the product being taken. Furthermore, the color represented in video pictures and photographs fade over time. (Civille Decl., ¶ 3, attached hereto as Exhibit B.) In addition, individuals do not have precise memories of color. Therefore, the current statements of David Howard or Jeff Dierenfeld in their respective affidavits about the color of a product from 1993 to 1997 are inherently unreliable. (Civille Decl., ¶ 4.)

¹²⁵ And, in fact, Plaintiffs fail to provide the L, A and B values of any product produced by the “Unitherm process” or any other objective color measurement or definition. In addition, there is no system or test that has been used to verify that the computer printouts attached as Exhibit Z to Plaintiffs’ Motion accurately reflect the color of a product with certain L, A and B values. Rather, the only way to verify the L, A and B values of a product is by using a Hunter-Lab Color Meter to measure the L, A and B values of that product. (Civille Decl., ¶ 3, Exhibit B.)

definition, however, this dispute over the construction of the term “golden brown” creates a question that defeats Plaintiffs’ motion.¹²⁶

Plaintiffs’ motion for partial summary judgment on invalidity should therefore be denied because:

1. Plaintiffs have not shown, by clear and convincing evidence, that the confidential demonstrations of the “Unitherm process” met each of the limitations of the claims of the ‘027 Patent and thus embodied the claimed invention. See Swift-Eckrich’s Response To Statement Nos. 7-9, 11-21, 23, 26, 28, 30, 32, 33, 35-38, 40, 42-44, 46, 48, 49, 51-54, 56, 57, 59, 64-67, 70, 74, 75.

2. Plaintiffs have not shown, by clear and convincing evidence, that Unitherm offered the “Unitherm process” for sale. In truth, the exhibits and facts all confirm that Unitherm only offered for sale equipment that could be used for many different processes. See Swift-Eckrich’s Response To Statement Nos. 10, 24, 29, 30, 34, 39, 44-47, 50, 53, 60-63, 68-71; 73, 90.

3. Plaintiffs have not shown, by clear and convincing evidence, that the “process” which Unitherm claims its sold to Thorn Apple Valley and Hudson Foods met each of the

¹²⁶ Plaintiffs also misconstrue the term “browning liquid pyrolysis product.” Plaintiffs rely on the application of “liquid smoke,” not a “browning liquid pyrolysis product” to show anticipation. (Plaintiffs’ Statement Of Material Facts, Nos. 2, 7, 13, 15, 21, 28, 33, 34, 37, 38, 39, 44, 45, 50, 51, 52, 53, 54, 56, 57, 58, 60, 64 and 69.) However, since there are a number of liquid smoke products which **do not** promote or effect a change in the color of the product, these liquid smoke products are not “browning liquid pyrolysis products” as that term is defined in the ‘027 Patent. (Salm Decl., ¶¶ 3, 4, attached hereto as Exhibit A.)

limitations of the claims of the '027 Patent and thus embodied the claimed invention. See Swift-Eckrich's Response To Statement Nos. 28, 29 and 48-54.¹²⁷

4. Plaintiffs have not shown, by clear and convincing evidence, that the videotapes which it sent to potential customers were adequate "printed publications" under 35 U.S.C. § 102(b) because the videotapes must "exhibit a substantial representation of the invention in such full, clear, and exact terms that one skilled in the art may make, construct and practice the invention without having to depend on either the patent or on his own inventive skills." Philips Elec. & Pharm. Indus. Corp. v. Thermal and Elecs. Indus., Inc., 450 F.2d 1164, 1169 (3rd Cir. 1971). Plaintiffs cannot meet this heavy burden because Mr. Howard testified that he could not remember any publication, including videos, before May 1997, that actually explained the process so that someone would be able to use it. (Howard Depo., 318:1-22.) See also Swift-Eckrich's Response To Statement Nos. 8, 16-21 and 48.¹²⁸

¹²⁷ In fact, contrary to Plaintiffs' assertions, Hudson Foods did not, prior to May 11, 1997, produce, sell and ship products which were processed using Maillose. See Plaintiffs' Statement No. 54. Rather, Hudson Foods sold product which were smoked using liquid smoke. And there is no evidence that, prior to May 11, 1997, Hudson Foods sold product which had a "golden brown" color. See Swift-Eckrich's Response To Statement No. 54.

¹²⁸ Of course, whether these videos are "printed" publications is a question of fact (Philips Elec. & Pharm. Indus. Corp. v. Thermal and Elecs. Indus., Inc., 450 F.2d 1164, 1170 (3rd Cir. 1971)) which must be approached on a case-by-case basis. Bristol-Myers Squibb Co. v. Boehringer Ingelheim Corp., 86 F. Supp. 2d 433, 444 (D.N.J. 2000). The fact issues to be considered in this determination are all disputed by Swift-Eckrich: "(1) the number of copies made; (2) their availability to the "public"; (3) the extent of the document's dissemination; and (4) the intent behind distribution." Id. Plaintiffs admit that the videotapes were not disseminated to the public without an agreement of confidentiality. See Plaintiffs' Response to Request For Admission No. 18, attached hereto as Exhibit E (sales materials promoting the "Unitherm process" were marked confidential). As significantly, Mr. Howard testified that he was not aware of any individual, who was not under an obligation of secrecy to Unitherm, which knew how to carry out his "process" before May 1997. (Howard Depo., 317:1-23; 314:10-315:14, attached hereto as Exhibit F.) Therefore, even assuming that individuals watching those videotapes learned how the "process" worked (which they did not), Plaintiffs admit that those individuals would have been under an obligation of secrecy.

5. And finally, Plaintiffs have failed to show, by clear and convincing evidence, that Unitherm's demonstrations, offers of sale, sales and printed publications of the "Unitherm process" included all of the following:

- (a) whether the product being browned was pre-cooked whole muscle meat;
- (b) whether the color of the product was "golden brown" as that term is defined in the '027 Patent;
- (c) whether a "browning liquid pyrolysis product" was applied to the pre-cooked whole muscle meats;
- (d) the percentage of pickup of the "browning liquid pyrolysis product" as claimed in the '027 Patent;
- (e) whether the "browning liquid pyrolysis product" contained a masking agent or flavoring enhancing composition as claimed in the '027 Patent;
- (f) whether the "browning liquid pyrolysis product" contained turkey flavor, turkey broth or a mixture of the two as claimed in the '027 Patent;
- (g) the temperature of the oven;
- (h) the temperature of the core of the product both before and after browning as claimed in the '027 Patent;
- (i) whether the pre-cooked whole muscle meat was predried prior to coating with a "browning liquid pyrolysis product" as claimed in the '027 Patent; and
- (j) whether the shrinkage of the product comports with the claims in the '027 Patent.

D. THERE IS NO EVIDENCE THAT SWIFT-ECKRICH COMMERCIALIZED ANY PRODUCT BEFORE MAY 11, 1997 THAT WAS PRODUCED THROUGH EXPERIMENTATION.

Plaintiffs claim that the '027 Patent is invalid because Swift-Eckrich commercialized its own process by using the Enercyst system in Wells, Minnesota. (Plaintiffs' Motion, pp. 37-38.) Plaintiffs are mistaken. First, Mr. Singh testified that Swift-Eckrich produced product in the Enercyst oven using a caramel solution, not a liquid pyrolysis product. See Swift-Eckrich's Response To Statement No. 84. Further, Mr. Singh testified that the process used in the Enercyst system was not the same as the process claimed in the '027 Patent and that a golden brown color was not obtained. (Singh Depo., 77:13-24; 82:8-23; 84:19-24, attached hereto as Exhibit K.)

In 1994, Swift-Eckrich experimented with using Maillose in its Enercyst system. Plaintiffs claim that Swift-Eckrich's request for label changes reflects an offer for sale. Again, Plaintiffs are mistaken. There is no evidence, let alone clear and convincing evidence, that any product, made in the course of Swift-Eckrich's experimentation, was sold. See Swift-Eckrich's Response To Statement No. 86. In State Indus., Inc. v. More-Flo Indus., Inc., 639 F. Supp. 937 (E.D. Tenn. 1986), the court drew a sharp distinction between preparations for sale and actual sales. The court found that the patentee's publication of price sheets for products made with the disputed process did not constitute an offer for sale. The court observed, "it would be of no consequence insofar as this defense is concerned, if [the patentee] had an entire warehouse full of water heaters produced by the patented method so long as they did not offer these water heaters for sale or allow their public use prior to the critical date." Id. at 940. Further, at least one patentee was successful in obtaining a reversal of a finding of an on-sale bar by showing that the sales of a product was "merely a method of disposing of the springs produced during the experimental period." See Lear Siegler,

Inc. v. Ark-Ell Springs, Inc., 569 F.2d 286, 291 (5th Cir. 1978). Plaintiffs' failure to meet their heavy burden of showing an actual sale of product - as opposed to the preparation for a potential sale of product by changing labels - defeats their motion on this issue.

E. PRIOR TO MAY 11, 1997, IT WAS NOT OBVIOUS, UNDER 35 U.S.C. § 103, TO PRODUCE A CONSISTENT “GOLDEN BROWN” COLOR USING A “BROWNING LIQUID PYROLYSIS PRODUCT”.

Plaintiffs also claim, without clear and convincing evidence (Rockwell Int'l Corp. v. U.S., 147 F.3d. 1358, 1364 (Fed Cir. 1998)), that it was obvious under 35 U.S.C. § 103 to produce a consistent “golden brown” product. (Plaintiffs’ Motion, pp. 35-38). The evidence is to the contrary. Mr. Singh testified that he could not consistently develop and maintain a golden brown color until January 1998. (Singh Depo., 193:4-8, attached hereto as Exhibit K.) Nor was the process claimed in the ‘027 Patent obvious to Mr. Howard. In 1998, Mr. Howard first produced a product that was “golden brown.” However, even that color “faded over time, and some of it developed a green ring under the surface.” (Salm Depo., 106:4-12, attached hereto as Exhibit P.)¹²⁹

Plaintiffs submit no affidavit challenging this collective testimony. Nor do Plaintiffs submit any affidavit claiming that it would have been obvious to one of ordinary skill in the art¹³⁰ to create a consistent “golden brown” color using a “browning liquid pyrolysis product.” In fact, since the parties disagree as to the construction of these terms, Plaintiffs cannot succeed on an obvious claim. The obviousness determination here, given the existence of genuine material issues of fact with respect to the meanings of terms used in these references, is not suitably disposed of by summary judgment under the rules pertaining thereto. The fact issues herein must be

¹²⁹ Mr. Singh also testified that “it’s not obvious at all” to use Maillose in the Enercyst system. (Singh Depo., 87:11-88:2, attached hereto as Exhibit K.) Similarly, Dr. Hussain testified that the use of Maillose in the Enercyst system emitted “some kind of gas that was objectionable to the people on the line . . . [and people] were complaining that it had an odor.” (Hussain Depo., 97:3-12, attached hereto as Exhibit G.)

¹³⁰ Plaintiffs, which must prove the level of ordinary skill in the art, have provided no evidence of that. Apple Computer, Inc. v. Articulate Sys., Inc., 234 F.3d 14, 26 (Fed. Cir. 2000).

resolved by trial in which the conflicting views of the experts will be subject to the refining fire of cross examination, a more effective means of arriving at the legal conclusion of obviousness vel non than perusal of ex parte affidavits and declarations of partisan experts lobbed at each other from opposing trenches.

Hodosh v. Block Drug Co., 786 F.2d 1136, 1143 (Fed. Cir. 1986), cert. denied, 479 U.S. 827 (1986).

See also Rockwell, Int'l., Corp. v. U.S., 147 F.3d 1358, 1366 (Fed. Cir. 1998) ("the prior art patents involved material factual issues genuinely in dispute, precluding summary judgment of anticipation. We must take the next step, however, and hold that these material issues also precluded a conclusion of obviousness on summary judgment").

Moreover, obviousness determinations require additional factual issues that are not required under a §102 analysis.

To establish invalidity under 35 U.S.C. § 103, certain factual predicates are required before the legal conclusion of obviousness or nonobviousness can be reached. The underlying factual determinations to be made are (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness, such as commercial success, long-felt but unsolved need, failure of others, copying, and unexpected results.

Apple Computer, Inc. v. Articulate Sys., Inc., 234 F.3d 14, 26 (Fed. Cir. 2000). Yet, Plaintiffs submit no evidence -- let alone clear and convincing evidence -- to support their claim of obviousness. For example, Plaintiffs do not consider evidence of "secondary considerations" (i.e.

“objective evidence of non-obviousness”),¹³¹ but merely assert that no secondary considerations exist. (Plaintiffs’ Motion, p. 36.)¹³²

In addition, contrary to Plaintiffs’ assertions, temperature and concentration may be patentable “if the results achieved at the designated concentrations are ‘unexpectedly good.’” Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804, 809 (Fed. Cir. 1989). Unexpected results (like Mr. Singh’s ability to finally develop a “golden brown” color consistently) is an issue of material fact that precludes summary judgment in this case. See, e.g., Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877 (Fed. Cir. 1998).

F. THERE IS NO CLEAR AND CONVINCING EVIDENCE OF INEQUITABLE CONDUCT BECAUSE SWIFT-ECKRICH DID NOT WITHHOLD ANY MATERIAL INFORMATION FROM THE PTO.

Inequitable conduct is not conducive to resolution on summary judgment. See, e.g., Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1583 (Fed. Cir. 1991); Baker Oil Tools, Inc. v. Geo Vann, Inc., 828 F.2d 1558, 1566, 4 USPQ 1210, 1215 (Fed. Cir. 1987) (“If the facts of materiality or intent are reasonably disputed, the issue is not amenable to summary disposition.”). In fact, the Federal Circuit has referred to claims of inequitable conduct as “an absolute plague” and summary judgment on this claim “ought to be, and can properly be, rare indeed.” Burlington Indus., Inc. v. Dayco Corp., 849 F.2d 1418, 1422 (Fed. Cir. 1988) (“A patent

¹³¹ The Federal Circuit has stated that “evidence of secondary considerations must always when present be considered in the process of determining obviousness, and that it may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious was not.” Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556 (Fed. Cir. 1985).

¹³² It should be noted that Plaintiffs do not dispute that the Description of Related Art in the ‘027 Patent (Col. 1:11-Col. 2:61) adequately describes the prior conventional approaches used in attempting to brown pre-cooked whole muscle meats, the need for a new approach, and the difference between the two.

litigant should be made to feel, therefore, that an unsupported charge of ‘inequitable conduct in the Patent Office’ is a negative contribution to the rightful administration of justice.”).

There are disputes of fact as to all of Plaintiffs’ claims that Swift-Eckrich intended to deceive¹³³ by its failure to disclose material information to the PTO.¹³⁴ As previously described in this Response: (1) Swift-Eckrich was not aware of the “Unitherm process” - - or that it was publicly used - - given Unitherm’s confidentiality agreements; (2) the “Unitherm process” is not the same as the invention claimed in the ‘027 Patent; (3) the “Unitherm process” was not on sale or in a printed publication; (4) Swift-Eckrich’s Enerecyst system is not the same as the process claimed in the ‘027 Patent; and (5) the Description of Related Art in the ‘027 Patent - which appears to encompass the “Unitherm process” - adequately describes the prior conventional approaches used in attempting to brown pre-cooked whole muscle meats.¹³⁵

Given these disputed issues of fact, summary judgment is inappropriate and Plaintiffs’ motion should be denied.

¹³³ Intent to deceive is an issue of fact, and is not conducive to resolution on summary judgment. See, e.g., Environ Prods. Inc. v. Total Containment Inc., 43 U.S.P.Q.2d 1288, 1290-1291 (E.D. Pa. 1997); KangaROOS U.S.A., Inc. v. Caldor, Inc., 778 F.2d 1571, 1577 (Fed. Cir. 1985) (“Although the intent element of fraud or inequitable conduct may be proven by a showing of acts the natural consequences of which were presumably intended by the actor, this requires the fact finder to evaluate all the facts and circumstances in each case . . . Such an evaluation is rarely enabled in summary proceedings.). Further, Plaintiffs have not produced any evidence that this threshold of intent has been met. Plaintiffs must provide evidence to support their allegation of deceptive intent, rather than an inference based on lack of disclosure. Hebert v. Lisle Corp., 99 F.3d 1109, 1116 (Fed. Cir. 1996).

¹³⁴ “Materiality” is information that “is not cumulative to information already of record or being made of record in the application, and (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or (2) It refutes, or is inconsistent with, a position the applicant takes in: (i) Opposing an argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability.” 37 C.F.R. § 1.56(b).

¹³⁵ “A reference need not be provided to the examiner if it is merely cumulative to or less material than other references before the examiner.” Upjohn Co. v. MOVA Pharm. Corp., 225 F.3d 1306, 1312 (Fed. Cir. 2000).

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Respectfully submitted,


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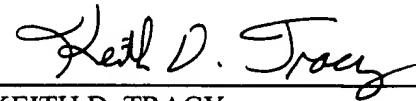
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This is to certify that on this 11th day of June, 2002, a true and correct copy of the above and foregoing was filed and has been mailed, postage prepaid to:

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